

### **DETAILED ACTION**

1. Receipt of the papers filed on March 10, 2009, is acknowledged. Claims 63-74 are pending.
2. Applicant's amendment to the specification to include a brief description of the drawings has overcome the objection to the specification.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

4. Claims 63-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan (6,916,414) in view of Schaedel (4,152,221) or Honda et al (6,690,573) or Covino (4,861,440) and further in view of the Lowenheim text *Electroplating* for the reasons of record.

### ***Double Patenting***

5. Claims 63-74 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,875,334 in view of Kinase et al (4,416,742) for the reasons of record.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 63-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Applicant has amended independent claim 63 to recite that the solution comprises “an essential content of at least one alkali metal”. It is not clear what an "essential content" is. The term does not appear to have been used in applicant’s specification.

***Response to Arguments***

9. Applicant's arguments filed March 10, 2009, have been fully considered but they are not persuasive. At page 6 of the Remarks, applicant points out that claim 63 now recites having an essential content of at least one alkali metal and argues that at column 5, line 48 Dolan teaches not to use alkaline metal hydroxide. This argument is not convincing. At column 5, lines 47-49 Dolan states “The anodizing solution, in certain embodiments, is essentially free of alkali metal hydroxide and/or fluorides and/or fluorosilicates.” This statement is limited to certain embodiments and does not suggest that alkali metal should never be included. To the contrary, at column 5, lines 39-41 Dolan states “Alkali metal salts of silicic acid and related species are especially suitable for use”. Thus, Dolan clearly teaches the inclusion of an alkali metal in the solution. Additionally, at column 2, lines 27-45, Dolan lists components of the anodizing

solution which are included especially preferred embodiments of the invention, and includes as element i) water-soluble and water-dispersible alkali metal hydroxides.

10. Applicant points out that claim 63 has been amended to recite that “a current density of between 2 and 12 A/dm<sup>2</sup> is provided” and argues that Dolan uses 100-200 A/m<sup>2</sup> (1-2 A/dm<sup>2</sup>).

This argument is not persuasive. At column 4, lines 29-30 Dolan states that “Typically, the current density will be from 100 to 300 amps/m<sup>2</sup>.” This corresponds to 1-3 A/dm<sup>2</sup>. Applicant’s claimed range of 2-12 A/dm<sup>2</sup> overlaps the range disclosed by Dolan in the 2-3 A/cm<sup>2</sup> region. Choice of a value from within the range disclosed by Dolan would have been obvious.. See MPEP 2144.05.

11. Applicant has also amended claim 63 paragraph d) to recite “direct current”. This limitation is not considered to distinguish applicant’s claim from Dolan. At column 4, line 9 Dolan states “Direct current is preferably used”.

12. Applicant further argues that the obvious-type double patent rejection is not believed to apply to the presently pending claims in view of the amendments to the claims. This argument is not convincing. Claim 1 of the 6,875,334 patent recites the inclusion of an alkali metal hydroxide in the anodizing solution. Claim 12 recites a current density of less than about 4A/dm<sup>2</sup>. This range overlaps the range recited in instant claim 63.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM T. LEADER whose telephone number is (571) 272-1245. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Leader/  
June 2, 2009.

/PATRICK RYAN/  
Supervisory Patent Examiner, Art Unit 1795